

REMARKS

Claims 1 – 4 and 7 – 11 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks. Claims 5 and 6 were previously canceled and claims 12 – 22 were previously withdrawn.

In the outstanding Office Action, the Examiner rejected claim 10 under 35 U.S.C. §112, second paragraph as being indefinite; rejected claims 1 and 9 under 35 U.S.C. §102(b) as being anticipated by previously cited U.S. patent no. 4,597,821 to Munro (hereinafter referred to as “the Munro ‘821 patent”); rejected claims 1, 2 and 7 under 35 U.S.C. §102(b) as being anticipated by previously cited U.S. patent no. 5,693,174 to Nakata et al. (hereinafter referred to as “the Nakata et al. ‘174 patent”); rejected claims 1 – 4 and 9 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent in further view of the Nakata et al. ‘174 patent; rejected claims 8 and 10 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent in further view of newly cited U.S. patent no. 6,432,237 to Hasenkamp et al. (hereinafter referred to as “the Hasenkamp et al. ‘237 patent”); and rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over the Munro ‘821 patent and the Nakata et al. ‘174 patent in further view of previously cited U.S. patent no. 3,239,402 to Ecklund et al. (hereinafter referred to as “the Ecklund et al. ‘402 patent”).

By this Response and Amendment:

claim 1 has been amended to recite a rotatable roller “further having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile;” and

claim 10 has been amended to provide antecedent basis for terms recited therein.

It is respectfully submitted that the above amendments do not introduce any new matter to this application within the meaning of 35 U.S.C. §132. Support for the amendments to claim 1 of

the present application is found on page 3, lines 7 – 9 of the originally filed specification.

Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 10 as being indefinite for insufficient antecedent basis.

Response

By this Response and Amendment, claim 10 has been amended to correct its dependency and to provide antecedent basis for the terms “cooling means” and “decorative layer.”

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Examiner’s rejection.

Rejections Under 35 U.S.C. §102(b)

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, or either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP '2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

1. The Munro '821 Patent

The Examiner rejected claims 1 and 9 as being anticipated by the Munro '821 patent.

Response

By this Response and Amendment, Applicants have amended claim 1 and, as amended, the rejection thereto and the claims dependent thereon are respectfully traversed.

As amended, claim 1 recites “an apparatus for applying a plastic edge strip on an edge of a plate-like workpiece comprising: extrusion means...; and forming means... comprising at least one rotatable roller..., having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece. Present application, claim 1 (emphasis added).

Contrastingly, the Munro '821 patent teaches a hand-held trigger operated adhesive hot melt gun. Munro further teaches the use of pressure rollers that can aid in the application of the adhesive to a curved surface. These pressure rollers are positioned in groups of three. However, nowhere in the reference, does Munro teach that an individual pressure roller has projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation. Rather, the group of pressure rollers simply acts to shape the adhesive to the curved surface – nothing more. The rollers themselves do not have projections and recesses.

In contrast, the forming means of the present application deforms the plastic material along the edge of the workpiece. In doing so, the projections and recess of the rollers provide an

ornamental feature to the plastic material. This is simply not present in the Munro '821 patent. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1. Similarly, since claim 9 depends from claim 1, it contains the limitations as recited therein. Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection to claim 9 also.

2. The Nakata et al. '174 Patent

The Examiner rejected claims 1, 2, and 7 as being anticipated by the Nakata et al. '174 patent.

Response

By this Response and Amendment, Applicants have amended claim 1 and, as amended, the rejection thereto and the claims dependent thereon are respectfully traversed.

As amended, claim 1 recites "an apparatus for applying a plastic edge strip on an edge of a plate-like workpiece comprising: extrusion means...; and forming means... comprising at least one rotatable roller..., having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile; the desired profile of the strand of plastic material is provided by the extruded strand being squeezed between the forming means and the edge of the workpiece. Present application, claim 1 (emphasis added).

The Nakata et al. '174 patent teaches a device comprising rolls that, as described in column 2, lines 35 to 40 of the cited patent, may serve for forming the molding in a shape suitable for covering the edge of the article. However as is shown in Fig 18. of the Nakata et al. '174 patent, the rolls of the device disclosed in the cited patent mainly serve for further pressing the extruded strand to the

edge of the workpiece, not for providing a patterned ornamentation to the strand.

In contrast, the forming means of the present application deforms the plastic material along the edge of the workpiece. In doing so, the projections and recess of the rollers provide a patterned ornamental feature to the plastic material. This is simply not present in the Nakata '174 patent. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claim 1. Similarly, since claims 2 and 7 depend from claim 1, they contain the limitations as recited therein. Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection to claims 2 and 7 also.

Rejections Under 35 U.S.C. §103(a)

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) that some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) that the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

1. The Munro '821 Patent in View of The Nakata et al. '174 Patent

The Examiner rejected claims 1 – 4 and 9 as being unpatentable over the Munro '821 patent in view of the Nakata et al. '174 patent.

Response

By this Response and Amendment, Applicants have amended claim 1 and, as amended, the rejection thereto and the claims dependent thereon are respectfully traversed.

The arguments above with respect to anticipation by the Munro '821 patent and the Nakata et al. '174 patent are herein incorporated by reference. As neither of the cited references teaches or

suggests a roller surface having projections or recesses or projections and recesses to provide the surface of the extruded strand of plastic material with ornamentation or a pattern as well as the profile, the present invention is patentable thereover. Accordingly, Applicant requests that the Examiner reconsider and withdraw the rejection to claim 1. Similarly, since claims 2 – 4 and 9 ultimately depend from claim 1, they contain the limitations as recited therein. Therefore, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection to claims 2 – 4 and 9 also.

2. The Munro ‘821 Patent In View Of The Hasenkamp et al. ‘237 Patent

The Examiner rejected claims 8 and 10 as being unpatentable over the Munro ‘821 patent in view of the Hasenkamp ‘237 patent.

Response

By this Response and Amendment, Applicants have amended claim 1 and, as amended, the rejection thereto and the claims dependent thereon are respectfully traversed. The arguments above, with respect to anticipation by the Munro ‘821 patent are herein incorporated by reference.

The Hasenkamp et al. ‘237 patent discloses improvement of a surface of a wood-based material by applying a formable coating material, smoothing the coating material, and heating the coating material. The cited patent discloses applying a decorative layer to the surface of a wood-based material; however, the cited reference does not teach or suggest applying such a decorative layer to the surface of a material using a roller having a surface having projections and/or recesses thereon. Therefore, the Hasenkamp et al. ‘237 patent does not account for the deficiencies of the Munro ‘821 patent. As such, claims 8 and 10, which contain all of the limitations of amended

independent claim 1, are patentable over the Munro '821 patent and the Hasenkamp et al. '237 patent as neither cited reference neither teaches nor suggests all of the limitations of claims 8 and 10.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of claims 8 and 10.

**3. The Munro '821 Patent and The Nakata et al. '174 Patent In View Of The
Ecklund et al. '402 Patent**

The Examiner rejected claim 11 as being unpatentable over the Munro '821 patent and the Nakata '174 Patent in view of the Ecklund et al. '402 patent.

Response

By this Response and Amendment, Applicants have amended claim 1 and, as amended, the rejection thereto and the claims dependent thereon are respectfully traversed. The arguments above, with respect to anticipation by the Munro '821 patent and the Nakata et al. '174 patent are herein incorporated by reference.

The Ecklund '402 patent discloses an apparatus for feeding a flat article along a linear path of travel, extruding a continuous ribbon of thermoplastic resin, applying a pressure against the ribbon to frictionally conform the ribbon about the edge of the flat article, and thereafter applying roll pressure to the ribbon on opposite sides of the article to firmly bond the ribbon thereto. However, the cited reference does not teach or suggest applying patterned ornamentation to the surface of a material using a roller having a surface having projections and/or recesses thereon. Therefore, the Ecklund et al. '402 patent does not account for the deficiencies of the Munro '821 patent nor the Nakata et al. '174 patent. As such, claim 11, which contains all of the limitations of amended independent claim 1, is patentable over the Munro '821 patent, the Nakata et a. '174 patent, and the Ecklund et al. '402

patent as the cited references neither teach nor suggest all of the limitations of claim 11.

Accordingly, therefore, reconsideration and withdrawal of the rejection is respectfully requested.


CONCLUSION

In light of the foregoing, Applicant submits that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicant respectfully requests that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

Respectfully submitted,
NATH & ASSOCIATES PLLC

Date: July 28, 2004
NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, DC 20005
(202) 775-8383

By:


Gary M. Nath
Registration No. 26,965
Marvin C. Berkowitz
Registration No. 47,421
Derek Richmond
Registration No. 45,771
Customer no. 20529